

REMARKS

Claim Rejections

Claims 1, 3, 7-9, 12, 14, 18-20, 33, 35, 39-41 and 43 stand rejected as obvious over Bennett '102 in view of Appellant's Admitted Prior Art (Specification 1:24 to 2:8), Bennett '178 and U.S. Patent No. 6,485,367 (Joshi).

Claims 4, 15, 36 and 44 stand rejected as obvious over Bennett '102 in view of Appellant's Admitted Prior Art, Bennett '178, Mayeroff and Joshi.

Claims 10, 11, 21 and 22 stand rejected as obvious over Bennett '102 in view of Appellant's Admitted Prior Art, Bennett '178, Walker and Joshi.

The Cited References

Joshi was filed on July 27, 2001. As shown by the attached Declaration of the inventor, Nicole Beaulieu, under 37 CFR 1.131, Applicant's claimed invention was conceived prior to the effective date, July 27, 2001, of Joshi. Thereafter, Applicant was diligent in having her patent application prepared and filed. As such, Joshi is not an effective reference.

Specifically, prior to July 27, 2001, Applicant conceived the idea of a gaming apparatus including a display unit, a value input device, and a controller coupled to the display unit and the value input device. The controller would include a processor and a memory. The controller would be programmed, as described and claimed in Applicant's patent application, to make an automated selection from among a plurality of user-selectable options in response to a request from a player, and according to the rules of a wagering game being played and according to a strategy to optimize the likelihood that the player would receive a value payout. Also, prior to July 27, 2001, Applicant conceived the idea of gaming method wherein, as described and claimed in her patent application, an automatic selection would be performed from among a plurality of user-selectable options in response to a request, and according to the rule of a wagering game being played and according to a strategy to optimize the likelihood that a player would receive a value payout. (Beaulieu Declaration, ¶2).

Also, prior to July 27, 2001, Applicant prepared a written description of her invention entitled "Bonus Game Quick Pick". The description of her invention noted, among other things, that the "player may chose to let the machine select the bonus elements thinking that the device will select the elements representing the best possible outcome." The description of Applicant's invention also noted that her invention was originally "disclosed via email" and "originally documented" prior to July 27, 2001. (See attached Exhibit A). That original document was an

entry (paragraph 3) in her patent lab book. (Beaulieu Declaration, ¶3). Please note that the dates on Exhibits A and B have been redacted.

On April 3, 2001, the written description of Applicant's invention was sent to Marty Hirsch, Esq. of Marshall, O' Toole, Gerstein, Murray and Borun (Marshall O'Toole) by Lena T. Van Asdale, Associate General Counsel for IGT. Ms. Van Asdale asked Mr. Hirsch "to review and prepare a new patent application" on Applicant's invention. Receipt of Ms. Van Asdale's letter of April 3, 2001 was acknowledged by Mr. Hirsch on April 4, 2001. Also, on that date, a new matter intake form for Applicant's invention was prepared at Marshall O' Toole. (Beaulieu Declaration , ¶4).

Subsequently, on April 16, 2001, Aaron M. Peters, an attorney at Marshall O'Toole, forwarded to Applicant via Federal Express a copy of a sample IGT patent application. The purpose of this correspondence was to provide her with an idea of how a patent application is structured. Also, on April 16, 2001, Mr. Peters faxed to Applicant a sample set of generic drawings. (Beaulieu Declaration, ¶5).

Thereafter, on April 30, 2001, Mr. Peters faxed to Applicant a couple of figures which might be included in her patent application. (Beaulieu Declaration, ¶6).

On November 29, 2001, Mr. Peters forwarded to Applicant an initial draft of her patent application, along with a document entitled "Patent Application Review Instructions". (Beaulieu Declaration, ¶7).

This draft was also sent to Ms. Van Asdale by Mr. Peters on December 4, 2001. (Beaulieu Declaration, ¶8).

Also, on December 4, 2001, Applicant received an email from Kimberly A. DiMino of IGT, requesting that she mark her comments directly on the draft application and then send it back to Ms. Van Asdale and to Ms. DiMino for forwarding to outside counsel. (Beaulieu Declaration, ¶9).

On December 5, 2001, Applicant replied to Ms. DiMino's email, indicating that she would do her best to review the draft application over the weekend. (Beaulieu Declaration, ¶10).

Subsequently, on December 19, 2001, Applicant replied to another email from Ms. DiMino, indicating that she would review the initial draft of the application over the upcoming four day weekend. (Beaulieu Declaration, ¶11).

On December 21, 2001, Ms. Van Asdale asked Mr. Peters for another copy of the draft application which was sent to her on November 29, 2001. (Beaulieu Declaration, ¶12).

In response, a copy of the draft application was forwarded to Ms. Van Asdale by Mr. Peters on December 27, 2001. (Beaulieu Declaration, ¶13).

Thereafter, Applicant discussed the draft application with Mr. Peters on January 4, 2002. At that time, Mr. Peters indicated that he would revise the draft application based on Applicant's comments. (Beaulieu Declaration, ¶14).

On January 8, 2002, a revised draft of Applicant's patent application was sent to her by Mr. Peters. (Beaulieu Declaration, ¶15).

Also, on that date, Mr. Peters forwarded to Applicant an Assignment and Declaration for her patent application. (Beaulieu Declaration, ¶16).

On January 14, 2002, Mr. Hirsch apparently sent a letter to Ms. Van Asdale, noting that a first draft of Applicant's patent application had been prepared and asked whether an Australian or PCT application should be filed prior to April 1, 2002. (Beaulieu Declaration, ¶17).

On January 16, 2002, Applicant received an email from Ms. DiMino asking whether she could come by and execute the formal papers for her patent application. (Beaulieu Declaration, ¶18).

On January 17, 2002, Applicant replied to Ms. DiMino's email stating that she would come by to execute the formal papers after she had again spoken with Mr. Peters. (Beaulieu Declaration, ¶19).

On January 18, 2002, Mr. Peters forwarded to Ms. DiMino via Federal Express an Assignment for Applicant's patent application stating "that were are preparing to file a PCT Application based on the above-referenced U.S. Patent Application prior to April 1, 2002...." (Beaulieu Declaration, ¶20).

The executed original Declaration and Assignment for Applicant's patent application was sent by Federal Express to Mr. Peters on February 1, 2002. (Beaulieu Declaration, ¶21).

Thereafter, Applicant's application was filed in the U.S. Patent and Trademark Office on February 11, 2002. A copy of the filed application and formal papers were sent by Mr. Peters to Ms. Van Asdale and Ms. DiMino on February 12, 2002. (Beaulieu Declaration, ¶22).

Conclusion

In view of the forgoing, it is respectfully submitted that all of the claims are now in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested.

If prosecution of this application can be assisted by telephone, the Examiner is requested to call the undersigned attorney at (510) 663-1100.

The Commissioner is hereby authorized to charge any additional fees, including any extension fees, which may be required or credit any overpayment directly to the account of the undersigned, No. 504480 (Order No. IGT1P530).

Respectfully submitted,
Weaver Austin Villeneuve & Sampson LLP

/William J. Egan, III/

William J. Egan, III
Reg. No. 28,411

P.O. Box 70250
Oakland, CA 94612-0250
510-663-1100